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DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553			LY, NGHI H	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/734,852
Filing Date: December 11, 2000
Appellant(s): KIM, HYUN-JEONG

Paul J. Farrell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/29/06 appealing from the Office action mailed 12/19/905.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

A. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of Itoh (US 5,280,521).

Regarding claim 21, John teaches a method of communicating a confirmation message (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), comprising the steps of: determining, when a voice call is not normally established between a called mobile station and a calling mobile station (see column 3, lines 8-9, "If calling party tries to call the mobile subscriber when not available"), if a called party of the called mobile station has confirmed a message created and transmitted by the calling mobile station (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45), generating, a confirmation message indicating the confirmation (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45), and transmitting, the confirmation message to the calling mobile station (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45).

John does not specifically disclose generating, by the called mobile station, a confirmation message indicating the confirmation by the called party, and transmitting, from the called mobile station, the confirmation message to the calling mobile station.

Itoh teaches generating, by the called mobile station, a confirmation message indicating the confirmation by the called party, and transmitting (see column 5, lines 2-6), from the called mobile station, the confirmation message to the calling mobile station (also see column 5, lines 2-6).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Itoh into the system of John in order to reduce the burden at the base station.

Regarding claim 22, John further teaches the message is a voice message (see Abstract).

Regarding claim 23, the combination of John further teaches the message transmitted by the calling mobile station is a text message (column 1, lines 34-55, see “electronic mail” and it reads on Applicant’s “text message”).

Regarding claim 24, John further teaches the confirmation message is a data burst message (see column 5, lines 10-35, “play”, “delete”, “played” and “unplayed” and see column 7, lines 39-45 and column 6, lines 34-36).

Regarding claim 25, John further teaches the confirmation message is a short message (see column 5, lines 10-35, “play”, “delete”, “played” and “unplayed”).

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B. Claims 16-19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of Itoh (US 5,280,521) and further in view of Choksi et al (US 6,477,243).

Regarding claim 16, John teaches a method of communication a confirmation message (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), comprising the steps of: informing a called mobile station of receipt of a message from a calling mobile station (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), determining, if the received message is a text message (column 1, lines 34-55, see "electronic mail" and it reads on Applicant's "text message") if a called party of the called mobile station has confirmed the received message (see Abstract, see column 5, lines 33-36), which is stores in the called mobile station (se column 1, lines 22-23), and transmitting (see Abstract, column 4, lines 41-49 and column 7, lines 39-44), a confirmation message to be delivered to the calling mobile station (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), wherein the confirmation message is generated when the called mobile station has confirmed the received message (see Abstract, column 5, lines 33-36, column 6, lines 30-40 and column 7, lines 39-45).

John does not specifically disclose transmitting, from the called mobile station, a confirmation message to be delivered to the calling mobile station, wherein the confirmation message is generated by the called mobile station when the called mobile station has confirmed the received message.

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Itoh teaches transmitting, from the called mobile station, a confirmation message to be delivered to the calling mobile station (see column 5, lines 2-6), wherein the confirmation message is generated by the called mobile station when the called mobile station has confirmed the received message (also see column 5, lines 2-6).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Itoh into the system of John in order to reduce the burden at the base station.

The combination of John and Itoh does not specifically disclose the confirmation message includes a telephone number of the calling mobile station.

Choksi teaches the confirmation message includes a telephone number of the calling mobile station (see column 9, lines 43-55).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Choksi into the system of John and Itoh so that a notification can be received by a particular user.

Regarding claim 17, John further teaches the step of determining, if the received message is a voice message (see column 6, lines 30-41 and see column 7, lines 39-45), whether the called mobile station is connected to a voice mail center in order to confirm the received voice message (see Abstract).

Regarding claim 18, John further teaches the confirmation message is a data burst message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed" and see column 7, lines 39-45 and column 6, lines 34-36).

Regarding claim 19, John further teaches the confirmation message is a short message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed").

Regarding claim 27, John and Itoh teaches claim 21. The combination of John and Itoh does not specifically disclose the confirmation message includes a telephone number of the calling mobile station.

Choksi teaches the confirmation message includes a telephone number of the calling mobile station (see column 9, lines 43-55).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Choksi into the system of John and Itoh so that a notification can be received by a particular user.

C. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of Itoh (US 5,280,521) and further in view of Choksi et al (US 6,477,243) and DeGiorgio et al (US 3,866,206).

Regarding claim 20, the combination of John, Itoh and Choksi teaches displaying, in the calling mobile station (see John, column 7, lines 39-45, see "displaying alphanumeric message"), information indicating receipt of the confirmation message, upon receipt of the confirmation message (also see John, column 7, lines 39-45, see "displaying alphanumeric message"). The combination of John, Itoh and Choksi does not specifically disclose sounding an alarm upon receipt of the confirmation message.

DeGiorgio teaches sounding an alarm upon receipt of the confirmation message (see column 9, lines 64-68 and see fig.5, beeper 156).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of DeGiorgio into the system of John, Itoh and Choksi so that the sender can response to the alarm faster.

D. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of Itoh (US 5,280,521) and further DeGiorgio et al (US 3,866,206).

Regarding claim 26, the combination of John and Itoh teaches displaying, in the calling mobile station (see John, column 7, lines 39-45, see “displaying alphanumeric message”), information indicating receipt of the confirmation message, upon receipt of the confirmation message (also see John, column 7, lines 39-45, see “displaying alphanumeric message”). The combination of John and Itoh does not specifically disclose sounding an alarm upon receipt of the confirmation message.

DeGiorgio teaches sounding an alarm upon receipt of the confirmation message (see column 9, lines 64-68 and see fig.5, beeper 156).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of DeGiorgio into the system of John and Itoh so that the sender can respond to the alarm faster.

(10) Response to Argument

On pages 5 and 7 of Appellant’s argument, Appellant argues that John in view of Itoh and Choksi does not teach the step of generating and transmitting, by the called

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mobile station, a confirmation message indicating the confirmation by the called party, the confirmation message is transmitted to the calling mobile station as recited in claims 16 and 21.

In response, Itoh does indeed teach the step of generating and transmitting, by the called mobile station, a confirmation message indicating the confirmation by the called party, the confirmation message is transmitted to the calling mobile station (see Itoh, column 5, lines 1-8, see “*The called mobile station verifies that it has received the message correctly, and then sends an answer signal to the calling party via the base station, and the calling party verifies that the message has reached the called mobile station”*). In this case, Itoh’s “an answer signal” reads on applicant’s “a confirmation message”, Itoh’s “transmitted” reads on applicant’s “transmitting”, Itoh’s “called mobile station” reads on applicant’s “called mobile station” or “called party”, and Itoh’s “calling party” reads on applicant’s “calling mobile station”, the teaching of Itoh does indeed teach “generating”, if not as alleged by the Appellant, Itoh’s invention will not have “an answer signal”).

On pages 5 and 7 of Appellant’s argument, Appellant argues that the calling terminal cannot check if the called party has confirmed the message, but can only check that the message is received in the called terminal (as admitted by the Appellant).

In response, the teaching of Itoh does indeed teach the calling terminal can check if the called party has confirmed the message (see Itoh, column 5, lines 1-8, see “*The called mobile station verifies that it has received the message correctly, and then sends an answer signal to the calling party via the base station, and the calling party*

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verifies that the message has reached the called mobile station". In this case, Itoh's "*has received the message **correctly***" reads on applicant's "confirmed"). In addition, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *the calling terminal can check if the called party has confirmed the message*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 5 of Appellant's argument, Appellant further argues that John does not teach a confirmation message is directly transmitted to a calling terminal.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *a confirmation message is directly transmitted to a calling terminal*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Nghi H. Ly




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The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

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